

DISPUTE RESOLUTION SERVICE

D00020277

Decision of Independent Expert

WOODBASS.COM

and

11 Denmark St

1. The Parties:

Complainant: WOODBRASS.COM
11-13 AVENUE DU NOUVEAU CONSERVATOIRE
Paris, France 75019

Respondent: 11 Denmark St
197 hao,kanlecuen
London WC2H 8LS
United Kingdom

2. The Domain Name:

woodbrass.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

05 June 2018 17:47 Dispute received
06 June 2018 15:15 Complaint validated
06 June 2018 15:20 Notification of complaint sent to parties
25 June 2018 02:30 Response reminder sent
28 June 2018 09:37 No Response Received
28 June 2018 09:37 Notification of no response sent to parties
06 July 2018 12:14 Expert decision payment received

4. Factual Background

The Complainant, WOODBRASS.COM, a French company registered since 1999, is a well-known online retailer of musical equipment. It has premises in Paris and in London. On March 8, 2000 the Complainant registered the domain name <woodbrass.com>, which it uses for its official website. The website is available in English, prices are mentioned in pounds and products can be ordered from the UK and delivered to the UK.

On November 17, 2015 the Complainant registered International trademark WOODBRASS, No. 1292631 for musical equipment and associated retail services. It has other trademarks and domain names incorporating the word WOODBRASS.

The Domain Name <woodbrass.co.uk> was registered in the name "11 Denmark St" on May 15, 2018. It resolves to a website displaying the words "WOODBRASS music instruments" and offering musical equipment online.

5. Parties' Contentions

Complainant

The Complainant's trademark WOODBRASS is well known. This can be established by a simple Google search of the word WOODBRASS, which gives about 2,5 million results. The <woodbrass.com> website attracts more than a million visitors per month. In 2015 the Complainant was rated 31st within the "top 100 of French web retailers".

The Domain Name is an Abusive Registration. The Complainant is the exclusive proprietor of the trademark WOODBRASS and has not authorized the registration of the Domain Name. The name and contact details of the registrant of the Domain Name are not available. There is no company registered under the name woodbrass.co.uk in the British register. It is obvious that the Respondent has no legitimate interest in registering or using the Domain Name, which identically reproduces the Complainant's registered trademark WOODBRASS. The country-code Top-Level Domain (ccTLD) ".co.uk" does not add any distinctiveness.

The Domain Name is confusingly similar to the trademark in which the Complainant has prior rights. It was primarily registered unfairly to disrupt the business of the Complainant.

The trademark WOODBRASS is reproduced on the Respondent's website, which is used for selling goods (musical equipment) identical to the goods offered via the Complainant's official website and for which the trademark WOODBRASS is registered. This constitutes trademark infringement.

There is a risk that the UK consumer will be confused and think that the Domain Name and the corresponding website belong to the Complainant. Given the identity of the signs and goods offered, it is clear that the Domain Name has been registered to catch the UK clientele of the Complainant's official website and to disrupt the business of the Complainant, at least in the UK.

In particular, there is a risk that the Respondent's website may be used for a fraudulent purpose. It may be assumed that there is no serious offer of products and that this website is used to obtain banking information and payments. Indeed, although the website is available only in English, it accepts 15 different currencies. Moreover, the physical address mentioned on the website is the address of another company which has no link with the Respondent and the phone number indicated on the website does not work.

The Respondent's website is used to attract the clientele of the Complainant. It targets UK consumers for the same goods through illegitimate use of the trademark WOODBRASS. It is obvious that the business of the Complainant's official website is unfairly disrupted if consumers think that <woodbrass.com> is linked to this fraudulent website.

The Domain Name is used by the Respondent in a way which is likely to confuse people into thinking that it is controlled by the Complainant. The Respondent's website displays the Complainant's WOODBRASS trademark and falsely states: "Woodbrass.CO.UK Music Store © since 2012 . All Rights Reserved. The trademarks and logos used in this website are owned by Woodbrass.CO.UK® and any unauthorized use of these trademarks by others is subject to action under state trademark laws". Obviously, the Respondent is trying to mislead consumers by taking advantage of the reputation and credibility of the Complainant.

The Domain Name is one of a series of registrations that the Respondent has made which correspond to trademarks or other well-known names in which the Respondent has no apparent interest. It seems that the Respondent has registered domain names identical to well-known retailers of musical equipment in order to disrupt their business in the UK, including <stevesmusic.co.uk> (the official website being www.stevesmusic.com). The overall presentation of the websites, the goods, the prices and the texts are identical.

Respondent

As mentioned, there was no Response.

6. Discussions and Findings

To obtain an order for the transfer of the Domain Name, the Complainant needs to show, on the balance of probabilities, that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration (DRS Policy, Paragraph 2).

As to Rights, but for the inconsequential ccTLD suffixes “.co.uk”, which may be disregarded, I find that the Domain Name <woodbrass.co.uk> is identical to the name WOODBRASS, in respect of which the Complainant has shown that it has registered trademark rights. The Domain Name is also identical or similar to the Complainant’s registered corporate name WOODBRASS.COM.

As to Abusive Registration, the DRS Policy, Paragraph 5.1 sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant invokes the following:

5.1.1.3: Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

In the absence of any Response, it is not disputed that the Complainant’s WOODBRASS trademark and its WOODBRASS corporate name are well known, not merely in France but also in the UK. The fact that the Respondent’s website offers for sale the same type of goods as those sold by the Complainant leads to the inevitable conclusion that the Respondent was well aware of the Complainant and its mark when registering the Domain Name.

The Complainant has demonstrated that the Domain Name is being used to resolve to a website displaying the Complainant’s trademark and purporting to conduct the kind of business carried on by the Complainant. This is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 5.1.1.3).

These circumstances also satisfy me, on the balance of probabilities, that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 5.1.2). Accordingly, I find that the Domain Name is an Abusive Registration. It is unnecessary to consider paragraph 5.1.3.

7. Decision

I direct that the Domain Name <**woodbrass.co.uk**> be transferred to the Complainant.

Signed Alan Limbury

Dated: July 12, 2018.